

REMARKS

Claims 1-3, 5-7, 9-11, 13-16, 24, 28, and 30 have been amended. Accordingly, Claims 1-30 are pending in the application. The reconsideration of the application is respectfully requested.

In May 7, 2003 Final Office Action, Claims 1-30 were rejected under 35 U.S.C. Section 103(a) as being obvious under Lamm in view of Kolling et al.

Briefly, the present invention provides a comprehensive bill presentment and bill payment system that receives bills from billers electronically and in hard copy form through the postal service and aggregates the bills of the consumer regardless of the implementation standards of individual billers. In other words, the present invention is not dependent on the evolution of competing electronic bill transmission standard. The present invention presents bills received electronically or bills received in hard copy via the postal service scanning and extracting billing information from paper bills.

Lamm provides a purely electronic EBPP system in which electronic bill files are redacted and reconstructed for presentment to the customer by selecting certain information from the electronic bill and adapting (e.g., inserting standard bill components) the billing information for presentment to the customer. In short, Lamm provides a method for preparing electronic bills for delivery by removing, deleting, or editing the billing information from electronic bill files.

Kolling et al. discloses an electronic statement presentment (ESP) system to replace the preparation and mailing of paper statements. The system disclosed by Kolling

et al. works exclusively with billers that have electronic delivery capabilities and, using statement data received electronically from a biller and a "stored" template, creates an electronic statement having the "look and feel" of a paper statement. Kolling et al. provide an electronic bill presentment and payment system to replace the printing, stuffing, and mailing of paper statements with electronic delivery (emphasis added) (see Kolling et al., column 4, lines 16-18).

Claim 1 distinguishes over Lamm and Kolling et al. by reciting a method of electronically presenting bills by allowing a customer to subscribe to a bill presentment system for receiving both electronic and paper-based bills for the customer. The distinguishing features of Claim 1 include the receiving, scanning, extraction, validation and presentation of billing information derived from paper-based bills. Applicants emphasize that all of the above steps relate to paper bills and the paper billing process. For example, Claim 1 recites steps for identifying the contents of the paper bill, scanning the paper bill, identifying the type of paper bill, extracting billing information from the paper bill using a predefined template, validating the extracted billing information derived from the paper bill, and presenting the extracted billing information to the customer (information the customer otherwise would have received from the paper bill).

The Examiner concedes that Lamm does not disclose the scanning step. Applicants further assert that Lamm does not disclose the identification of content step, the identification of bill type step, the extracting of billing information step, validation step, and the presentment of extracted bill step. Lamm only provides presentment of

electronic bills and does not integrate a consumer's paper bills with their electronic bills. Lamm merely redacts electronic bill files by separating sensitive and non-sensitive billing information.

Kolling et al. do not cure the deficiencies of Lamm. Kolling et al. disclose an ESP system that does not accept paper bills (Kolling et al., Abstract, "system [which] replaces the preparation and mailing of paper statements and invoices from biller"). Kolling et al.'s objective is to eliminate the paper billing process (see Kolling et al., column 4, lines 16-18) and provides a template tool for converting electronic bill files into PDF format using Adobe. The Adobe software disclosed by Kolling et al. is used with the template authoring workstation (TWAS) to create electronic bill statements (Kolling et al. , column 10, line 7; see also column 9, lines 49-67).

Kolling et al. only discloses that "scan/capture software [may be used] for converting scanned images to PDF with automatic OCR" (Kolling et al., column 10, lines 18-20). Kolling et al. do not disclose identifying the contents of the paper bill or extracting billing information using a predefined template. In addition, Kolling et al. do not validate the extracted billing information (emphasis added). No where in the Kolling et al. patent does it mention even receiving a paper bill.

Thus, Lamm and Kolling et al., taken alone or in combination, do not disclose or suggest the steps of Claim 1 for the reasons given above.

Furthermore, Lamm teaches away from paper billing and wants to replace the use of existing paper bills and check to reduce the printing, processing, and postage costs of

paper billing ("The system should replace the use of existing paper bills and checks to reduce the printing, processing, and postage costs of paper billing." Lamm, column 3, lines 62-64).

Similarly, Kolling et al. also teach away from the present invention. For example, Kolling et al., in the first sentence of the Abstract, state that they provide a "system [which] replaces the preparation and mailing of paper statements and invoices from biller with electronic delivery" (Kolling et al., Abstract). See also Kolling et al., column 4, lines 16-18 ("The present invention replaces the printing, stuffing, and mailing of paper statements with the power and efficiency of electronic delivery."). Kolling et al. provides electronic authoring tools to create electronic statements with the same "look and feel" as paper statement to reduce the costs associated with preparation and mailing of paper statement (Kolling et al., column 4, lines 52-55). Kolling et al. completely abolish paper bills from the ESP process; thus, the system of Kolling et al. does not accommodate paper bills. In fact, Kolling et al. assert that the features provided by Kolling et al. "are not possible in the traditional paper-based process that uses either the post office or a courier to deliver paper statements" (Kolling et al., column 4, lines 47-49) (emphasis added).

Teaching away is the antithesis of the art's suggestion that one of ordinary skill in the art move in the claimed direction. Teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.

Cir. 1988). Furthermore, MPEP Section 2144.05 affirms that "[a] prima facie case of obviousness ... [is] rebutted by showing that the art, in any material respect, teaches away from the claimed invention."

Based on the foregoing, it is submitted that Lamm and Kolling et al. do not provide a basis for combining the teachings of the references. Therefore, Applicants respectfully submit that the 103(a) rejection of Claim 1 should be withdrawn.

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that neither Lamm nor Kolling et al., whether taken singly or combined, teach or suggest each and every limitation of independent Claim 1. It is submitted that Claim 1 clearly distinguishes over Lamm and Kolling et al. and is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 1 under 35 U.S.C. §103(a) should be withdrawn.

Claims 2-8 are dependent upon Claim 1 and are believed to be patentable with the parent Claim 1.

Claim 9, recites the steps of receiving, scanning, extracting, validating, and presenting billing information derived from paper bills in a manner similar to Claim 1, and thus, distinguishes over Lamm and Kolling et al. for the same reasons given above. In addition, Claim 9 further distinguishes over Lamm and Kolling et al. by reciting the step of receiving and processing a paper bill and extracting an image of the payment remittance stub from the paper bill.

As discussed above, neither Lamm nor Kolling et al. interacts with a paper billing process. Although Kolling et al. refer to scanning/capture software, Kolling et al. neither disclose nor suggest identifying the content of a paper bill, extracting billing information from the scanned paper bill, and validating the extracted information. Instead, Kolling et al. insert electronic billing information into an electronic template to produce an electronic bill that looks like a paper bill.

In fact, Kolling et al. do the opposite of the present invention. Namely, Kolling et al. insert electronic billing information into an electronic template to produce an electronic bill that looks like a paper bill. Kolling et al. advocate the use of electronic delivery and provide electronic templates for facilitating electronic presentation of electronic statement data received from billers with electronic delivery. Kolling et al. use Adobe PDF to convert incoming electronic bills to PDF producing exact replicas of the incoming electronic bills for presentment on any computer platforms.

Furthermore, as discussed earlier, both Lamm and Kolling et al. teach away from the paper billing process. Thus, there would be no motivation to combine the cited references to obtain the claimed invention of Claim 9. Because Lamm and Kolling et al. cannot be combined, the step of extracting a remittance stub as recited in of Claim 9 is not obvious. Further, it is not obvious from Lamm or Kolling et al. to extract an image of the remittance stub from the paper bill because neither Lamm nor Kolling et al. interact with the paper billing process; they only interact with electronic billers.

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that neither Lamm nor Kolling et al., whether taken singly or combined, teach or suggest each and every limitation of independent Claim 9. It is submitted that Claim 9 clearly distinguishes over Lamm and Kolling et al. and is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 9 under 35 U.S.C. §103(a) should be withdrawn.

Claims 10-12 are dependent upon Claim 9 and are believed to be patentable with the parent Claim 9.

Claim 13, recites the steps of receiving, scanning, extracting, validating, and presenting paper bills in a manner similar to Claim 1, and thus, distinguishes over Lamm and Kolling et al. for the same reasons given above. Claim 13 further distinguishes over Lamm and Kolling et al. by reciting extracting an image of the remittance stub, storing a scanned image of a remittance stub for the paper bills and printing the stored scanned image of the remittance stub for the paper bill. With this feature, the customer can choose to use online payment options or print the remittance stub to manually pay the biller through the postal service.

As discussed above, Lamm does not disclose the steps of scanning, extracting, validating and presenting billing information derived from paper bills. Furthermore, Lamm does not disclose the step of storing the remittance stub and printing the remittance stub. Lamm is simply an electronic system incapable of interacting with a paper billing process.

As disclosed by Kolling et al., "problems result when consumers do not pay the entire amount due on the payment stub, the payment stub becomes not computer-readable, or the consumer does not mail the payment stub with the payment" (Kolling et al., column 1, lines 64-67). In addition, Kolling et al. states that the remittance stub process "requires large amounts of time and money to process paper bills, checks, and stubs" (Kolling et al., column 2, lines 1-3). Thus, Kolling et al. effectively teach away from the use of a remittance stub as claimed (emphasis added).

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that neither Lamm nor Kolling et al., whether taken singly or combined, teach or suggest each and every limitation of independent Claim 13. It is submitted that Claim 13 clearly distinguishes over Lamm and Kolling et al. and is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 13 under 35 U.S.C. §103(a) should be withdrawn.

Claims 14-15 are dependent upon Claim 13 and are believed to be patentable with the parent Claim 13.

Independent system Claims 16, 24 and 28 are written in a fashion similar to independent method Claims 1, 9, and 13, respectively. All arguments presented herein for Claims 1, 9 and 13 apply equally to Claims 16, 24 and 28, respectively. Therefore, in view of the distinctions and advantages as noted above with respect to Claims 1, 9, and 13, it is respectfully submitted that neither Lamm nor Kolling et al., whether taken singly or combined, teach or suggest each and every limitation of independent Claims 16, 24,

and 28. It is submitted that Claims 16, 24 and 28 clearly distinguish over Lamm and Kolling et al. and are believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claims 16, 24 and 28 under 35 U.S.C. §103(a) should be withdrawn.

Claims 17-23 are dependent upon Claim 16 and are believed to be patentable with the parent Claim 16.

Claims 25-27 are dependent upon Claim 24 and are believed to be patentable with the parent Claim 24.

Claims 29-30 are dependent upon Claim 28 and are believed to be patentable with the parent Claim 28.

In summary, Claims 1-30 are believed to be allowable for the reasons given herein. Accordingly, these claims remain pending following entry of this Amendment, and are believed to be in condition for allowance at this time. As such, Applicants respectfully request entry of the present Amendment and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicants' undersigned representative at the number listed below.

Respectfully submitted,
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Application No. 09/277,189
August 1, 2003
Reply to Office Action of May 7, 2003

Page 22

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